

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. The Applicant appreciates the telephone interview between the Examiner Jonathan Ouellette, the inventor Marc Groz, and Attorney Glenn Foster. The Examiner discussed the rejections under 35 U.S.C. § 101, 35 U.S.C. § 102, and 35 U.S.C. § 103.

CLAIMS

The Office Action dated 9/21/2004 rejected claims 1-28. Claims 24-27 are cancelled. New claims 29-41 are added. Claims 1-23 and 28 are amended by this response. Claims 1-23 and 28-41 are currently pending in the application.

35 U.S.C. § 101

In the Office Action dated September 21, 2004, claims 13, 17, 20, 21, 24 to 27 are rejected under 35 U.S.C. § 101, because the Office Action indicates that the claimed subject matter is directed to non-statutory subject matter. The Applicant submits for at least the following reason that these claims are directed to statutory subject matter. A two-pronged test was described in the Office Action that include:

- a) whether the invention is within the technological arts; and
- b) whether the invention produces a useful, concrete, and tangible result.

The Applicant submits that the currently-amended claims satisfy both of these requirements. Programmed computer language such as can be embodied in software, hardware, and/or firmware has been accepted in many cases as not being excepted from the technological arts simply because it utilizes a computer or is a business method claim, such as *State Street Bank and Trust Co. v. Signature Financial Group*.

The second prong of the test that considers whether the invention produces a useful, concrete, and tangible result is also satisfied by the present claims. In claim 13, for example, the tangible results include a method for providing a valuation estimate. Applicant submits that the method for providing a valuation estimate produces a concrete result (namely the valuation), and thereby satisfies both prongs of the 35 U.S.C. § 101 test, for similar reasons for as the court held in *State Street Bank*. The valuation estimate is derived utilizing one or more computers or a computing mechanism as claimed.

Applicant submits that providing a valuation estimate is far from an abstract idea, and is, in many embodiments, of value to one or more agents that are attempting to determine a suitable valuation using the claimed method. The Applicant submits that claims 20, 21, and 24-27 are allowable for the same reason as independent claim 13 which they depend from, and as such, include the claim limitations thereof.

Claim 17 includes language pertaining to updating a database, also provides a useful, concrete, and tangible result. Claim 17 includes language pertaining to the valuation module, and the negotiation module, as described in the detailed description, and each module includes language relating to a computer and/or a database. Performing calculations to be used for valuation of a quantity, as well as determining a mutually acceptable price for one or more trading items, represent two examples of tangible items that are derived from the method claim 17. The Applicant submits that claim 18 should be allowed for the same reason as independent claim 17 which it depends from, and as such, incorporates the claim limitations thereof. Claim 18 further includes computer language as does claim 17.

For at least the above reasons, the Applicant submits that the rejection to claims 13, 17, 20, 21, 24 to 27 under 35 U.S.C. § 101 is inappropriate considering the integrated computer language of the claims, and the claimed results that are tangible, and requests that the rejection be withdrawn as to these claims.

35 U.S.C. § 102

In the Office Action dated September 21, 2004, claims 1, 12, 14, 19, 22, 23, and 28 are rejected under 35 U.S.C. § 102, as being anticipated by Israel et al. (US Patent No. 6,766,367, hereinafter, the "Israel et al.").

The Applicant respectfully disagrees with the characterization of Israel et al. in the rejection under 35 U.S.C. § 102. The characterizing language in the Office Action mirrors the language of the Applicant's claims. While the Applicant agrees that there may be certain similarities between Israel et al. and the claimed invention, the Applicant disagrees with many of the characterizations of Israel et al. To respond to the characterizations in the rejection on an element-by-element basis, the Applicant would have to describe in detail what Israel et al. actually discloses for each recited

characterized element of Israel et al., as compared to the claim language of the present disclosure that the Office Action virtually quoted to describe Israel et al. Considering the scope and length of Israel et al. that has been characterized using Applicant's own claim language, responding to the characterizations of Israel et al. on an element-by-element basis would require a lengthy response. Indeed, Applicant believes that many of the claim amendments make many of the rejections irrelevant. The Applicant will focus on certain distinctions between Israel et al. and the presently claimed invention.

The Applicant further emphasizes that the present rejection is under 35 U.S.C. § 102, and as such to overcome this rejection, the Applicant is only required to provide a distinction between the claimed invention and the Israel et al. The Applicant will provide several distinctions.

The preamble to claim 1, as amended, recites a method for using at least one computer to process contingent commitments relating to at least one business venture involving one or more agents. While there may or may not be structural similarities between a computer-mediated decision-making group in which multiple agents utilize to process contingent commitments and a non-judicial dispute resolution, they are simply not the same thing as required under the anticipation rejection of 35 U.S.C. § 102. The Office Action should not consider obviousness concepts to provide support for the anticipation rejection under 35 U.S.C. § 102. A claimed invention directed at potential business ventures is not the same as cited prior art that pertains to a dispute resolution.

To determine what is meant by a contingent commitment, such as recited in the preamble and other portions of claim 1, one must consider pages 6 to 9 of the specification that describe the contingent commitment module. These pages describe a computer-mediated decision-making process. The present disclosure relates to business ventures between one or more agents. Furthermore, claim 1 includes the language, "wherein the contingent commitments include at least one modal operator or quantifier". The Applicant submits that there is no teaching in the dispute resolution technique of Israel et al. to utilize a modal operator or quantifier.

The Office Action further rejected claim 12 under 35 U.S.C. § 102 as being anticipated by Israel et al. The claim language of claim 12 contains similar, though not

identical, limitations as claim 1. Therefore, for at least the reasons as described above, the anticipation rejection to claim 12 of Israel et al. should be withdrawn.

Claim 14 has been rejected over Israel et al. under 35 U.S.C. § 102. Claim 14, as amended, recites among other things a method for using one or more computing mechanisms by two trading parties to determine a mutually acceptable price for one or more trading items. Israel et al. teaches a dispute resolution technique that differs fundamentally from the determining the mutually acceptable price of the present disclosure. Therefore, for at least the reasons as described above, the anticipation rejection to claim 14 of Israel et al. should be withdrawn. Claim 28 depends from claim 14, and thereby includes the limitations of claim 14. For at least that reason, the Applicant submits that the Israel et al. rejection under 35 U.S.C. § 102 to claim 28 should be withdrawn.

The Office Action further rejected claim 22 under 35 U.S.C. § 102 as being anticipated by Israel et al. The claim language of claim 22 contains similar, though not identical, limitations as claim 14. Therefore, for at least the reasons as described above, the anticipation rejection to claim 22 of Israel et al. should be withdrawn. Claim 23 depends from claim 22, and thereby includes the limitations of claim 22. For at least that reason, the Applicant submits that the Israel et al. rejection under 35 U.S.C. § 102 to claim 23 should be withdrawn.

35 U.S.C. § 103

In the Office Action dated September 21, 2004, claims 2-3, 5-7, and 9 are rejected under 35 U.S.C. § 103, as being anticipated by Israel et al. in view of Thiessen (US Patent No. 5,495,412, hereinafter, "Thiessen").

The Applicant respectfully disagrees with the characterization of Israel et al. and Thiessen in the rejection under 35 U.S.C. § 103. The characterizing language in the Office Action largely mirrors the language of the Applicant's claims. While the Applicant agrees that there may be certain similarities between either Israel et al. or Thiessen, and the claimed invention, the Applicant disagrees with, and does not accept, many of the characterizations of Israel et al. and/or Thiessen. To respond on an element-by-element basis to the characterizations in the rejection, the Applicant would have to

describe in detail what Israel et al. actually discloses for each recited characterized element of Israel et al. and/or Thiessen, as compared to the claim language of the present disclosure that the Office Action virtually quoted to describe Israel et al. and/or Thiessen.

Considering the scope and length of Israel et al. or Thiessen that has been characterized using Applicant's own claim language, responding to the characterizations of Israel et al. on an element-by-element basis would require a lengthy response. Additionally, the Applicant believes that the amendments to the claim language make many of the rejections irrelevant. Instead, the Applicant will focus on certain distinctions between Israel et al. and/or Thiessen and the presently claimed invention.

As to the rejection to claims 2-3, 5-7, and 9, Israel et al. discloses a non-judicial dispute resolution management operation. Consider that dispute resolution permeates Israel et al. Each of the independent claims directs the invention of Israel et al. to dispute resolution. Figures 3 and 4 include detailed language to dispute resolution. This is also true of the negotiation portion of Israel et al. on column 24-28. Consider, following the equations on column 24, Israel et al. states "In other words, for the above example, the dispute will "settle for the value of the plaintiff's demand if the plaintiff's demand is below the value of the plaintiff's offer; 2) settle for the average between the plaintiff's demand and the defendant's offer if the plaintiff's demand is within 30% of the defendant's offer; or 3) not settle if the plaintiff's demand is above 30% of the defendant's offer. (Column 24, lines 15-21 Israel et al). One skilled in the art, upon considering Israel et al., would consider Israel et al. for concepts relating to dispute resolution, not business venture concepts.

By comparison, claim 1 of the present disclosure, which claims 2-3, 5-7, and 9, includes the preamble language "A method for using at least one computer to process contingent commitments relating to at least one business venture involving one or more agents". The background starts with the language "Most new ventures fail. A frequently cited reason for this failure is lack of sufficient capital...". As such, claim 1 is directed to business ventures. The rejection under 35 U.S.C. § 103 in the Office Action relies upon the teachings of the present disclosure in formulating the rejection. It would not be obvious to one skilled in the art, upon consideration of Israel et al., to consider the teachings of Israel et al., and to apply Israel et al. to a business venture.

Thiessen discloses a computer-based method and apparatus for interactive computer-assisted negotiations. Applicant contends that Thiessen does not suggest negotiating a value of a contingent commitment, wherein the contingent commitments include at least one modal operator or quantifier, as claimed herein.

The Applicant thereby submits that claims 2-3, 5-7, and 9, that depend from claim 1, are allowable over the combination of Israel et al., in view of Thiessen for the same reason as described above with respect to the 35 U.S.C. 102 rejection since that rejection relied upon the Israel et al. patent. There is no suggestion in Thiessen et al. to apply the non-judicial dispute resolution of Israel et al. to business ventures.

The Applicant further notes new claim 31, which recites "The method of claim 1, wherein the contingent commitments produces one or more contingent solutions". Contingent solutions are defined on page 8, lines 4-10, of the application as originally filed.

Claims 8 and 10 are also rejected under 35 U.S.C. § 103 over Israel et al. in view of Thiessen. Claims 8 and 10 both also depend from claim 1, and thereby inherently contain the language of claim 1. As such, Applicant maintains that it is inappropriate to maintain the rejection to these claims.

Applicant agrees with the Office Action that both Israel et al. and/or Thiessen fail to show many claimed features (see, e.g., paragraphs 24, 30, 33, 36, 39, 42, 46, and 49). The Applicant does not agree, however, (in the respective paragraphs that follow these paragraphs), that these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited since the claims have been amended to make the claims comply with method claim terminology.

Claims 4, 11, 15, and 16 are rejected under 35 U.S.C. 103 as being unpatentable over Israel et al. Claims 4 and 11, that depend from claim 1, thereby both include claim language pertaining to business ventures and contingent commitments. As described above, Israel et al. does not suggest applying the dispute resolution concepts to business ventures, as claimed. It would not be suggested, to one skilled in the art, to apply dispute resolution concepts to business ventures.

Paragraphs 37 and 38 of the Office Action indicate that the claim 11 distinctions pertain to "nonfunctional descriptive material". The Applicant submits that these claims

have been amended to make the claims comply with method claim terminology, and as such the claims are, as amended, indeed functional.


As per claims 15 and 16, which depend from claim 14, the Applicant submits that Israel et al. does not disclose, among other things, "performing a calculation using the one or more computing mechanisms to determine whether the determining the mutually acceptable price (also within the claim: for the one or more trading items) between the first agent and the second agent results in the mutually acceptable price", which language is in claim 14. Once again, Applicant submits that Israel et al. is directed at a dispute resolution mechanism, and does not suggest using one or more computers to determine a mutually acceptable price for one or more trading items.

CONCLUSION

In view of the forgoing remarks, Applicant respectfully requests reconsideration and allowance of the subject matter application including claims 1-23, and 28-41.

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(Date)

Respectfully Submitted,



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